

REMARKS

The Office Action dated September 8, 2006, has been received and carefully considered. In this response, claims 1, 6 and 7 have been amended, and claims 2, 4, 5, 8-16, 18-19, 32 and 39 have been cancelled without prejudice. Entry of the amendments to claims 1, 6 and 7 is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. THE INDEFINITENESS REJECTION OF CLAIMS 1, 5, 17, 20-22, 25-29, 31, 34, 36-37 AND 41

On pages 2-3 of the Office Action, claims 1, 5, 17, 20-22, 25-29, 31, 34, 36-37 and 41 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is hereby respectfully traversed. Each allegation is addressed below.

1) In claim 1, the term an "initiation document... containing requirement information" is vague and indefinite. What is the scope of the requirement information?

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of requirement information. *See, e.g.,* Page 5, lines 11-20.

2) Claim 5 is vague and indefinite with respect to the term of "automatically generating" the letter of Credit. Claim 1 reads on receiving information consistent with either a purchase order or a request for a letter of credit. What is the scope of "automatically" generating a "Letter of Credit"?

Response: While Applicant disagrees that "automatically" is not vague and indefinite, Applicant has nonetheless amended claim 1 to remove the term. Further, Applicant respectfully

that one of ordinary skill in the art would appreciate from the reading the specification the particulars of the "generating" step of claim 1. *See, e.g.,* Page 5, lines 18-19.

3) In claim 17, generating a "sales order" is vague and indefinite. Who are the parties to the sales order? How does the sales order differ from the purchase order of claim 2?

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of "sales order." *See, e.g.,* Page 7, lines 7-12.

4) In claim 20, the algorithm of for comparing the sales order to the requirement information is vague and indefinite. What is being compared?

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the algorithm. Applicant has nonetheless amended the claim to recite the term "particulars."

5) In claim 21, the scope and contents of a manufacturing specification sheet is vague and indefinite. Also the algorithm for comparing the manufacturing specification sheet to the sales order is unclear.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of a "manufacturing specification sheet" and the algorithm. *See, e.g.,* Page 7, lines 14-19. Applicant has nonetheless amended the claim to recite the term "particulars."

6) In claim 22, the "matched sales" lacks antecedent basis. Moreover, the algorithm for automatically generating shipping instruction using the matched sales order is vague and indefinite.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of a “matched sales” and the algorithm. Applicant respectfully submits that proper antecedent support is provided in claim 21 and 20.

7) In claim 26, the algorithm for automatically generating the invoice using the sales order is vague and indefinite.

Response: While Applicant disagrees that “automatically” is not vague and indefinite, Applicant has nonetheless amended claim 26 to remove the term. Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the algorithm.

8) In claim 27, the algorithm for comparing the invoice to the matched sales order is indefinite.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the algorithm. Applicant has nonetheless amended the claim to recite the term “particulars.”

9) In claim 28, the step of comparing the shipping instructions to the matched invoice is indefinite.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the step. Applicant has nonetheless amended the claim to recite the term “particulars.”

10) In claim 29, the algorithm for automatically generating shipping instructions using the matched invoice is vague and indefinite.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the algorithm. While Applicant disagrees that

“automatically” is not vague and indefinite, Applicant has nonetheless amended claim 29 to remove the term.

11) In claim 31, the trade documents lack antecedent basis. Also, the step of automatically generating the trade documents using the matched invoice and matched shipping instructions is vague and indefinite.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the step. While Applicant disagrees that “automatically” is not vague and indefinite, Applicant has nonetheless amended claim 31 to remove the term. Further, Application respectfully submits that “trade documents” has proper antecedent basis in claim 1.

12) In claim 34, the step of presenting the documents to the buyer for negotiation is vague and indefinite. What is being negotiated?

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the step. *See, e.g.,* Page 8, lines 12-15.

13) In claims 36 and 37, the reconciliation step is vague and indefinite.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of the step. *See, e.g.,* Page 8, lines 11-20.

14) In claim 41, the term in proximity is vague and indefinite.

Response: Applicant respectfully submits that one of ordinary skill in the art reading the specification would appreciate the meaning of “in proximity.” While Applicant disagrees that “proximity” is not vague and indefinite, Applicant has nonetheless amended claim 41 to remove the term.

In view of the foregoing, it is respectfully requested that the aforementioned objection to claims 1, 5, 17, 20-22, 25-29, 31, 34, 36-37 and 41 be withdrawn.

II. THE ENABLEMENT REJECTION OF CLAIM 1

On page 3 of the Office Action, claim 1 was rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. This rejection is hereby respectfully traversed.

As stated in MPEP § 2164.03, a single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements. In re Vickers, 141 F.2d 522, 61 USPQ 122 (CCPA 1944); In re Cook, 439 F.2d 730, 169 USPQ 298 (CCPA 1971). The claimed invention pertains to a predictable electrical art. Furthermore, the claims are supported by several disclosed embodiments. Thus, the observation that the claims may encompass some embodiments which have *not* been explicitly disclosed does not provide a basis for rejection of the claims under 35 U.S.C. § 112, first paragraph.

In view of the foregoing, it is respectfully requested that the aforementioned enablement rejection of claim 1 be withdrawn.

III. THE ANTICIPATION REJECTION OF CLAIMS 1-7, 17, 20-31, 33, 34-38 AND 40-41¹

¹ Applicant respectfully submits that while the Office Action sets forth rejections for claims 1-7, the substantive merits of claims 17, 20-31, 33, 34-38 and 40-41 are not addressed. As a result, Applicant is not able to substantively discuss those claims in this Amendment/Response, other than to argue that they are patentable for the reasons set forth in independent claim 1, from which they all depend. Accordingly, Applicant respectfully requests that the next office action -- which of course cannot be final -- properly address all pending claims.

On pages 3-4 of the Office Action, claims 1-7, 17, 20-31, 33, 34-38 and 40-41 were rejected under 35 U.S.C. § 102(b) as being unpatentable over Green (U.S. Publication No. 2003/0191710). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

Although Applicants do not agree with the pending rejections, Applicants have nonetheless amended the claims to clarify the claimed systems and methods and better distinguish the cited reference. In particular, independent claim 1 has been amended to recite the steps:

- maintaining a customer profile containing standard terms and conditions used by the buyer;
- receiving from the buyer an initiation document containing requirement information with respect to the trade operation;
- mapping at least some of the requirement information into a database;

- generating a letter of credit if the initiation document is a purchase order or an application for a letter of credit, wherein the letter of credit is generated based on the requirement information and the customer profile;

- automatically generating the trade documents required by the trade operation utilizing the requirement information contained in the database letter of credit; and

- verifying the accuracy of the trade documents throughout the trade operation.

Applicant respectfully submits that the Green reference does not teach or suggest all of the above features or functionality. For example, Applicant respectfully submits that there is no feature or functionality in Green that "generat[es] a letter of credit if the initiation document is a purchase order or an application for a letter of credit, wherein the letter of credit is generated based on the requirement information and the customer profile," as expressly required by independent claim 1, as amended. In fact, as evidenced by the following excerpt from Green, Applicant respectfully submits that Green merely discloses a system and method for the tracking and reconciling of trade documents, but does teach or suggest any feature or functionality relating to the generation of trade documents in the manner claimed by the above application:

An improved method and system for tracking and reconciling invoices and other payment devices, purchase orders and corresponding letters of credit is disclosed. In the system and method, information about the purchase orders and corresponding letters of credit received from the customer are compared against the performance of the manufacturer. Differences are identified automatically. Differences on the purchase order/SKU level are identified automatically and are used by the customer to determine the destiny of the order, control inventory, decide subsequent shipping, warehousing and pricing issues. The differences are communicated to the customer and may be used by the financial institution in deciding to authorize payment. Discrepancies are automatically identified and codified and are used by the customer and/or financial institution in deciding payment. Reconciliation information is also provided to the customer to aid in reconciling the customer's books in view of the plurality of purchase orders.

See Abstract, Green Publication (emphasis added).

Therefore, as is evident from the above excerpt and the balance of the Green disclosure, Applicant respectfully submits that Green does not teach or suggest any feature or functionality that "generat[es] a letter of credit if the initiation document is a purchase order or an application for a letter of credit, wherein the letter of credit is generated based on the requirement information and the customer profile." Accordingly, Applicants respectfully submit that independent claim 1, as amended, is allowable over the cited reference.

Claims 17, 20-31, 33, 34-38 and 40-41 are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 17, 20-31, 33, 34-38 and 40-41 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 20 -- which depends from claim 1 via claim 17 -- recites the additional steps of comparing the sales order to the requirement information contained in the database in order to determine any discrepancies, and correcting the sales order if there are any discrepancies, thereby generating a matched sales order." Applicant respectfully submits that the Green reference does not teach or suggest any such feature or functionality.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-7, 17, 20-31, 33, 34-38 and 40-41 be withdrawn.

IV. REQUEST FOR INFORMATION

In response to the Examiner request for the names of any products or services that have incorporated the claimed subject matter, Applicant respectfully submits the solution called Tradedoc®, which is described in more detail on the one-page description attached hereto as Exhibit A.

Applicant respectfully requests that the Examiner contact the undersigned if additional information is required.

V. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,
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